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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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24126	7590	03/21/2005	EXAMINER	
ST. ONGE STEWARD JOHNSTON & REENS, LLC			CEGIELNIK, URSZULA M	
986 BEDFORD STREET			ART UNIT	
STAMFORD, CT 06905-5619			PAPER NUMBER	

3714

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/736,182

Applicant(s)

ISENBERG, BARBARA L. SN

Examiner

Urszula M. Cegielnik

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification does not provide adequate support for "pressure-sensitive adhesive layer". The Specification refers to reusable adhesives in paragraph 19 of the Specification. The Specification makes no mention of a pressure-sensitive adhesive layer. The Specification discloses a product known by the trademark, MemoACT®. The trademark or trade name cannot be used properly to identify any particular material or product. This limitation raises the issue of new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said sticky layer" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Gates.

Gates discloses a toy comprising at least one cutout having an at least partially printed surface (col. 4, lines 58-61), said printed surface at least partially covered by an at least semi-transparent sticky layer (col. 4, lines 58-61) for releasably adhering accessories (14,16,18,20), wherein said sticky layer is washable (the flock 24 is inherently washable) such that when washed and allowed to dry, said sticky layer (flock 24) substantially returns to an initial stickiness; said cutout is a figure (col. 4, line 21, i.e. a paper doll) and said printed surface (col. 4, lines 58-61) displays an image of said figure; said printed surface is completely covered by said sticky layer (see Figures 1 and 2, for example); portions of said printed surface are covered by said sticky layer (24); a multiplicity of cutouts (12,14,15,18,20); said accessories (14,15,18,20) relate to said printed surface; said accessories (14,16,18,20) relate to a common theme; a cutout having an at least partially printed surface, said printed surface completely covered by an at least semi-transparent sticky layer (col. 4, lines 58-61) for releasably adhering accessories (14,16,18,20) related to said printed surface, wherein said sticky layer is washable (the flock 24 is inherently washable) such that when washed and allowed to

Art Unit: 3714

dry, said sticky layer substantially returns to an initial stickiness; said cutout is a figure (col. 4, line 21, i.e. a paper doll) and said printed surface depicts an image of said figure (the image of a doll); said accessories (14,16,18,20) relate to a common theme; a cutout having a surface at least partially covered by an at least semi-transparent sticky layer (col. 4, lines 58-61) for releasably adhering accessories, wherein said sticky layer is washable (the flock 24 is inherently washable) such that when washed and allowed to dry, said sticky layer substantially returns to an initial stickiness; said surface is at least partially printed (col. 4, lines 58-61); said accessories (14,16,18,20) relate to said printed surface; said accessories relate to a common theme. A book comprising at least one cutout having an at least partially printed surface, said printed surface at least partially covered by an at least semi-transparent sticky layer (24) for releasably adhering accessories (14,16,18,20) wherein said sticky layer is washable (the flock 24 is inherently washable) such that when washed and allowed to dry, said sticky layer substantially returns to an initial stickiness; said accessories (14,16,18,20) relate to a common theme; said accessories (14,16,18,20) relate to said printed surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gates in view of McCarn.

Art Unit: 3714

Gates discloses the claimed invention except for the figure being a teddy bear.

McCarn discloses a figure in the form of a teddy bear.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a figure in the shape of a teddy bear as taught by McCarn, since such a modification would provide aesthetic appeal for the toy.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gates in view of Nachbar.

Gates discloses the claimed invention except for the substrate being in the form of a book.

Nachbar discloses a plurality of toy sheet accessories in a book format for play.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the substrate in the form of a book as taught by Nachbar, since such a modification would permit an alternate substrate to be used for support of cutouts.

Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gates in view of Smith.

Gates discloses the claimed invention except for the substrate being in the form of an activity board.

Smith discloses an activity board with a plurality of figures and associated accessories.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the substrate in the form of an activity board as taught by

Art Unit: 3714

Smith, since such a modification would permit an alternate substrate to be used for support of cutouts.

Response to Arguments

Applicant's arguments filed 25 August 2004 have been fully considered but they are not persuasive.

Applicant argues that Gates does not disclose "an at least semi-transparent pressure-sensitive adhesive layer". The Examiner submits that Gates indeed teaches a semi-transparent pressure-sensitive adhesive layer as noted at col. 4, lines 58-61 and further at col. 5, lines 5-8. The non-drying adhesive layer allows an accessory such as slip 16 to be disposed on the body of the display object 10 and is pressed gently into place.

Applicant further contends that "pressure-sensitive adhesive" is considered to be a term of art noting a special class of adhesives that provide good adhesion to a surface while at the same time allow for ease of peelability or removability from the surface to which they stick, not producing any damage to or leaving a visible layer of adhesive polymer on such a surface. As reiterated here and under *Claim Rejections - 35 USC § 112*, the Specification refers to reusable adhesives in paragraph 19 of the Specification. The Specification makes no mention of a pressure-sensitive adhesive layer. The Specification discloses a product known by the trademark, MemoACT®. The trademark or trade name cannot be used properly to identify any particular material or product. Thus, because the structure of the pressure-sensitive adhesive layer cannot be gleaned from the trademark MemoACT® and further sufficient description of a pressure-

Art Unit: 3714

sensitive adhesive layer is lacking, it raises the issue of new matter.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 571-272-4420. The examiner can normally be reached on Monday through Friday, from 5:45AM - 2:15PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 571-272-4419.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.



**DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700**

Application/Control Number: 10/736,182

Page 8

Art Unit: 3714

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Assistant Examiner
Art Unit 3714